

REMARKS

Claims 1-20 are pending in the present application.

Claims 1-20 have been rejected.

No claims have been allowed.

Reconsideration of the claims is respectfully requested.

Objections to the Specification

On Page 2 of the October 10, 2003 Office Action the Examiner objected to Page 19 of the Specification because Page 19 referred to reference numbers but did not indicate what figure was being discussed. In response, the Applicant has amended Page 19 of the specification to refer to Figure 1. The Applicant respectfully submits that this amendment overcomes the objection to the Specification. Additional amendments have been made to the Specification to correct typographical errors. No new matter has been added as a result of these amendments.

35 U.S.C. § 102 (Anticipation)

Claims 1-8 and Claims 10-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent Application No. 2002/0164991 to *Arazi et al.* (hereafter "*Arazi*"). These rejections are respectfully traversed.

It is axiomatic that a prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single

reference, arranged as they are in the claims. MPEP § 2131; *See, In re King*, 231 USPQ 136, 138 (Fed. Cir. 1986) (citing with approval, *Lindemann Maschinenfabrik v. American Hoist and Derrick*, 221 USPQ 481, 485 (Fed. Cir. 1984)); *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 USPQ 619, 621 (Fed. Cir. 1985).

With respect to any of Claims 1-8 and Claims 10-20, a determination of anticipation in accordance with Section 102 requires that each feature claimed therein be described in sufficient detail in *Arazi* to enable one of ordinary skill in the art to make and practice the claimed invention.

The Applicant respectfully disagrees with the Examiner's assertions regarding the subject matter disclosed in the *Arazi* reference. The Applicant respectfully submits that the *Arazi* reference does not show each and every limitation of the Applicant's invention. The Applicant directs the Examiner's attention to Claim 1, which contains unique and novel elements:

1. (Original) In a fixed wireless access (FWA) communication system having at least a first fixed-site base station and at least a first fixed-site subscriber station capable of communicating with the first fixed-site base station, an improvement of apparatus for facilitating radio communication with a mobile station, said apparatus comprising:
a first local-network radio transceiver positioned at the at least the first fixed-site subscriber station said first local-network radio transceiver for selectably transceiving communication signals with the mobile station upon a first local radio link formed between the first local-network radio transceiver and the mobile station when the mobile station is positioned within a selected range of the first fixed-site subscriber station. (Emphasis added).

The Examiner stated that “Referring to claim 1, Arazı et al teaches in a fixed wireless access (FWA) communication system having at least a first fixed-site base station (0082) and at least a first fixed-site subscriber station (Figure 1; 107, 108, 109) capable of communicating with the first fixed-site base station, an improvement of apparatus comprising: a first local-network radio transceiver positioned at the at least the first fixed-site subscriber station (Figure 1) said first local network radio transceiver for selectably transceiving communication signals with the mobile station upon a first local radio link formed between the first local-network radio transceiver and the mobile station (0014 and Figure 1) when the mobile station is positioned within a selected range of the first fixed-site subscriber station (0065). The WPBX base station is equated with the fixed site subscriber station and the switch with the fixed site base station.” (October 10, 2004 Office Action, Page 2, Line 17 to Page 3, Line 4). The Applicant respectfully traverses these assertions of the Examiner.

Claim 1 is directed to a first local-network radio transceiver positioned at a first fixed-site subscriber station of a fixed wireless access (FWA) communication system. The Applicant respectfully submits that the *Arazı* reference does not disclose a fixed wireless access (FWA) communication system of the type that comprises a first fixed site subscriber station.

The Examiner has stated that the switch shown in the *Arazı* reference (switch 129) is “equated” with a fixed site base station. The Applicant respectfully submits that switch 129 of *Arazı* is not a base station (and not a fixed site base station of a fixed wireless access (FWA) communication system). This may be seen by referring to Paragraph [0082] of *Arazı* which indicates that (1) switch 129 may comprise a standard computer, and (2) switch 129 may be a part of a base

station or a part of several base stations. Therefore it is clear that while switch 129 may be a computer that is part of a base station, switch 129 is not a base station. That is, other elements must be added to switch 129 to make a base station.

The Examiner also stated that a WPBX base station of *Arazi* is “equated” with a fixed site subscriber station a fixed wireless access (FWA) communication system. The Applicant respectfully submits a WPBX base station of *Arazi* (e.g., base station 107, 108 or 109) is not equivalent to a fixed site subscriber station of a fixed wireless access (FWA) communication system. This may be seen by the fact that the each of the WPBX base stations 107, 108 and 109 are only able to communicate over relatively short distances. “Base station 107, 108 and 109 of a WPBX system cover cells 102, 103 and 104, respectively, each having relatively smaller coverage areas.” (*Arazi*, Paragraph [0064]). A mobile handset 110 communicates with base stations 107, 108 and 109 with a “short-range communication link 106.” (*Arazi*, Paragraph [0065]).

The *Arazi* reference does not comprise a fixed-site subscriber station of a fixed wireless access (FWA) communications system and does not comprise a first local-network radio transceiver positioned at a first fixed-site subscriber station. Therefore, Claim 1 of the invention is not anticipated by the *Arazi* reference.

The *Arazi* reference states that the *Arazi* invention “deals largely with how communication with a Mobile Unit such as a handset is handed off (or passed off) from one Base Station to another (neighboring) Base Station when the handset moves from one minicell to another minicell.” (*Arazi*, Paragraph [0071]). The *Arazi* reference does not disclose the elements of the Applicant’s invention.

Claims 2-15 depend directly or indirectly on Claim 1. Therefore, Claims 2-15 incorporate all of the limitations of Claim 1. Because the *Arazi* reference does not disclose all of the elements of Claim 1, then the *Arazi* reference also does not disclose all of the elements of Claims 2-15. Therefore, Claims 2-15 of the invention are not anticipated by the *Arazi* reference.

Claim 16 of the invention comprises unique and novel elements that are analogous to the unique and novel elements of Claim 1. The Applicant directs the Examiner's attention to Claim 16 which contains unique and novel elements:

16. (Original) In a method for communicating in a fixed wireless access (FWA) communication system having at least a first fixed-site base station and at least a first fixed-site subscriber station capable of communicating with the first fixed-site base station, an improvement of a method for facilitating radio communications with a mobile station, said method comprising:

positioning a first local-network radio transceiver at the at least the first fixed-site subscriber station; and

selectably transceiving communication signals with the mobile station when a first local radio link formed between the first local-network radio transceiver and the mobile station when the mobile station is positioned within a selected range of the first fixed-site subscriber station. (Emphasis added).

For the reasons previously set forth, the Applicant respectfully submits (1) that the *Arazi* reference does not disclose a fixed wireless access (FWA) communication system of the type that comprises a first fixed site subscriber station, and (2) that switch 129 of *Arazi* is not a base station (and not a fixed site base station of a fixed wireless access (FWA) communication system), and (3) that the *Arazi* reference does not disclose a first local-network radio transceiver positioned at a first fixed-site subscriber station of a fixed wireless access (FWA) communication system. Therefore, Claim 16 of the invention is not anticipated by the *Arazi* reference.

Claims 17-20 depend directly or indirectly on Claim 16. Therefore, Claims 17-20 incorporate all of the limitations of Claim 16. Because the *Arazi* reference does not disclose all of the elements of Claim 16, then the *Arazi* reference also does not disclose all of the elements of Claims 17-20. Therefore, Claims 17-20 of the invention are not anticipated by the *Arazi* reference.

For the foregoing reasons, the Applicant respectfully submits that the Examiner's rejections of Claims 1-8 and Claims 10-20 under 35 U.S.C. § 102 have been overcome.

The Applicant respectfully submits that the rejections of Claims 1-8 and Claims 10-20 should be withdrawn and that Claims 1-8 and Claims 10-20 are now in condition for allowance. For these reasons Applicant respectfully requests reconsideration and allowance of Claims 1-8 and Claims 10-20.

35 U.S.C. § 103 (Obviousness)

Claim 4 was rejected under 35 U.S.C. § 103(a) as being obvious over *Arazi* in view of United States Patent No. 5,115,463 to *Moldavsky et al.* (hereafter "*Moldavsky*") and further in view of United States Patent No. 6,379,119 to *Raves*. Claim 9 was also rejected under 35 U.S.C. § 103(a) as being obvious over *Arazi* in view of United States Patent No. 6,363,252 to *Hamalainen et al.* (hereafter "*Hamalainen*"). These rejections are respectfully traversed.

During *ex parte* examinations of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142;

In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of non-obviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant's disclosure. MPEP § 2142.

Applicant respectfully submits that the Patent Office has not established a *prima facie* case of obviousness with respect to Claim 4 of the Applicant's invention. The Applicant hereby repeats

and incorporates by reference all of the Applicant's remarks that have previously been made concerning the *Arazi* reference.

The Examiner rejected Claim 4 as being obvious in view of the *Arazi* reference in combination with the *Moldavsky* reference and the *Raves* reference. (October 10, 2004, Pages 8-9). The Applicant respectfully traverses this rejection.

Claim 4 depends indirectly from Claim 1. Therefore, Claim 4 incorporates all of the limitations of Claim 1. Because the *Arazi* reference does not disclose all of the elements of Claim 1, then the *Arazi* reference also does not disclose all of the elements of Claim 4. The Applicant respectfully submits that Claim 4 is not obvious in view of the *Arazi* reference. The Examiner stated that Claim 4 is unpatentable because Claim 4 is obvious in view of the combination of the *Arazi* reference and the *Moldavsky* reference and the *Raves* reference.

The Examiner stated that it would be obvious to one skilled in the art at the time the invention was made to combine the teachings of the *Arazi* reference with the teaching of the *Moldavsky* reference and with the teachings of the *Raves* reference. The Applicant respectfully traverses this conclusion of the Examiner.

Under the applicable patent law, there must be some teaching, suggestion or motivation to combine the *Arazi* reference with the *Moldavsky* reference and with the *Raves* reference. "When a rejection depends on a combination of prior art references, there must be some teaching, or motivation to combine the references." *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). "It is insufficient to establish obviousness that the separate elements of an

invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the references.” *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997). The Applicant respectfully submits that there exists no teaching, suggestion or motivation in the prior art to combine the teachings of the *Arazi* reference with the teachings of the *Moldavsky* reference and with the teachings of the *Raves* reference.

When two references are combined the combination of the references must teach or suggest all the claim limitations. In the present case, even if the *Arazi* reference were combined with the *Moldavsky* reference and the *Raves* reference, the combination of the three references would not teach, suggest or even hint at the Applicant’s invention. This is because, as previously described, the *Arazi* reference does not teach, suggest, or even hint at the Applicant’s concept of positioning a first local network radio transceiver at a first fixed site subscriber station of a fixed wireless access (FWA) communications system. The Applicant respectfully submits that the rejection of Claim 4 under 35 U.S.C. §103(a) combining the *Arazi* reference and the *Moldavsky* reference and the *Raves* reference should be withdrawn.

The Applicant respectfully submits that Claim 4 is patentable over the *Arazi* reference and over the *Moldavsky* reference and over the *Raves* reference whether taken individually or in combination. The Applicant respectfully requests that the rejection of Claim 4 be withdrawn and that Claim 4 be passed to issue.

Claim 9 was rejected under 35 U.S.C. § 103(a) as being obvious over *Arazi* in view of United States Patent No. 6,3631,252 to *Hamalainen et al.* (hereafter “*Hamalainen*”).

The Applicant respectfully traverses this rejection.

Applicant respectfully submits that the Patent Office has not established a *prima facie* case of obviousness with respect to Claim 9 of the Applicant's invention. The Applicant hereby repeats and incorporates by reference all of the Applicant's remarks that have previously been made concerning the *Arazi* reference.

Claim 9 depends indirectly from Claim 1. Therefore, Claim 9 incorporates all of the limitations of Claim 1. Because the *Arazi* reference does not disclose all of the elements of Claim 1, then the *Arazi* reference also does not disclose all of the elements of Claim 9. The Applicant respectfully submits that Claim 9 is not obvious in view of the *Arazi* reference. The Examiner stated that Claim 9 is unpatentable because Claim 9 is obvious in view of the combination of the *Arazi* reference and the *Hamalainen* reference.

The Examiner stated that it would be obvious to one skilled in the art at the time the invention was made to combine the teachings of the *Arazi* reference with the teaching of the *Hamalainen* reference. The Applicant respectfully traverses this conclusion of the Examiner.

Under the applicable patent law (cited above) there must be some teaching, suggestion or motivation to combine the *Arazi* reference with the *Hamalainen* reference. The Applicant respectfully submits that there exists no teaching, suggestion or motivation in the prior art to combine the teachings of the *Arazi* reference with the teachings of the *Hamalainen* reference.

When two references are combined the combination of the references must teach or suggest all the claim limitations. In the present case, even if the *Arazi* reference were combined with the

Hamalainen reference, the combination of the two references would not teach, suggest or even hint at the Applicant's invention. This is because, as previously described, the *Arazi* reference does not teach, suggest, or even hint at the Applicant's concept of positioning a first local network radio transceiver at a first fixed site subscriber station of a fixed wireless access (FWA) communications system. The Applicant respectfully submits that the rejection of Claim 9 under 35 U.S.C. §103(a) combining the *Arazi* reference and the *Hamalainen* reference should be withdrawn.

The Applicant respectfully submits that Claim 9 is patentable over the *Arazi* reference and over the *Hamalainen* reference whether taken individually or in combination. The Applicant respectfully requests that the rejection of Claim 9 be withdrawn and that Claim 9 be passed to issue.

The Applicant respectfully submits that the rejections of Claim 4 and Claim 9 should be withdrawn and that Claim 4 and Claim 9 are now in condition for allowance. For these reasons Applicant respectfully requests reconsideration and allowance of Claim 4 and Claim 9.

The Applicant respectfully requests reconsideration and allowance of Claims 1-20.

The Applicant reserves the right to submit further arguments in support of Applicant's above-stated position, as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like. The Applicant denies any position or averment of the Examiner that is not specifically addressed by the foregoing argument and response.

SUMMARY

For the reasons given above, the Applicant respectfully requests reconsideration and allowance of the pending claims and that this patent application be passed to issue.

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this patent application, the Applicant respectfully invites the Examiner to telephone the undersigned attorney. The Commissioner is hereby authorized to charge any additional payment that may be due or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: March 10, 2004

A handwritten signature in dark ink, appearing to read "W.A. Munck", is written over a horizontal line.

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